

PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

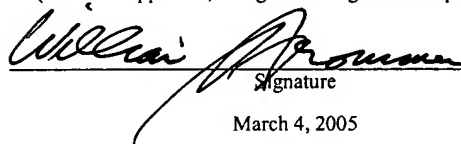
Applicants: Stephen Mark KEATING et al.
Serial No.: 10/006,294
Filed: December 6, 2001
For: **EMBEDDING DATA IN MATERIAL**
Examiner: Samir Ahmed
Art Unit: 2623

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 4, 2005.

William S. Frommer, Reg. No. 25,506

(Name of Applicant, Assignee or Registered Representative)


Signature

March 4, 2005

Date of Signature

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

This is in response to the Office Action dated February 4, 2005, wherein restriction was required among the claims as follows:

Group I, claims 1-24, 34, 36-38 and 59-62, directed to "embedding information;"

Group II, claims 25-33 and 35, directed to “embedding and removing information;” and

Group III, claims 39-58, directed to “comparing and storing difference data.”.

Applicants elect, with traverse, Group I claims 1-24, 34, 36-38 and 59-62.

It is respectfully submitted that, contrary to the Examiner's argument, the claims of Groups I and II are directed to substantially the same invention and the requirement for restriction between the claims of Group I and the claims of Group II should be withdrawn. The claims of Group II all depend, either directly or indirectly, from claim 1 of Group I. Thus, all of the Group II claims necessarily recite the features of claim 1. While the Examiner is correct in noting that the claims of Group I may be construed as a subcombination of the claims of Group II, the fact that all of the Group II claims recite the same limitations as are found in claim 1 of Group I is sufficient to withdraw the present requirement. After all, no burden is placed on the Examiner to examine both the Group I claims and the Group II claims because he will have to search and consider the very same limitations when examining each Group.

It is submitted that a search for the invention defined by the Group II claims will require a search that encompasses the claims of Group I and, thus, both groups of claims of the instant application will be searched. Therefore, if the present requirement for restriction is maintained, the logical result will be the filing of a divisional application to include the claims encompassed by the non-elected group. Of course, this will mean that the examination of such claims will be delayed. However, since the search for the claims included in the divisional application will overlap with and, in all probability, be identical to the search that is to be conducted on the Group I claims elected herein, the primary effort needed to examine all

applications will be repeated. Furthermore, it is likely that the same Examiner will be in charge of the divisional case; but in light of the delay between the prosecution of the present application and that of the divisional application, the Examiner will have to conduct a duplicate, redundant search at a later time. Alternatively, if a different Examiner is assigned to the divisional application, a significant loss of PTO efficiency will result in his examination of that divisional case. After all, the present Examiner will be the individual in the best position to examine all applications and he will be fully familiar with the subject matter of the divisional application.

Therefore, since the only logical outcome of the present restriction requirement would be to delay the examination of the claims included in Group II, resulting in inefficiencies on the part of the Office and unnecessary expenditures by Applicants, and since the single search can be done for all claims without any significant burden on the Office, the withdrawal of the instant restriction requirement and the examination on the merits of claims 1-38 and 59-62 are respectfully solicited.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicant

A handwritten signature in black ink, appearing to read 'William S. Frommer', is written over a horizontal line.

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